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DILLON, SAMUEL A

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN GOLD
and ROBERT GIBSON

Appeal 2009-014993
Application 10/684,207
Technology Center 2100

Before GREGORY J. GONSALVES, ERIC B. CHEN and BRUCE R.
WINSOR, *Administrative Patent Judges*.

GONSALVES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-27, all the claims pending in the application. (App. Br. 3.) We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The Invention

Exemplary claim 1 follows:

1. A method comprising:

receiving a list comprising media and at least two backup devices, wherein a first medium of the list is assigned to a first backup device, and a second medium of the list is assigned to a second backup device;

ordering the list by physical location of the at least two backup devices based on proximity of the remaining backup devices of the at least two backup devices to the first backup device; and

presenting at least the media portion of the ordered list to a user.

The Examiner rejected claims 1-9, 13-15, 19-22, and 24-27 under 35 U.S.C. § 103(a) as being unpatentable over Bolin (U.S. Patent 5,664,146) in view of Jennings (“Using Access 97”). (Ans. 3-9.)

The Examiner rejected claims 10-12, 16-18 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Bolin, Jennings and Kanai (U.S. Patent Pub. 2002/0152181). (Ans. 10-11.)

ISSUE

Appellants' responses to the Examiner's positions present the following issue:

Does the combination of Bolin and Jennings teach or suggest "ordering the list by physical location of the at least two backup devices based on proximity of the remaining backup devices of the at least two backup devices to the first backup device," as recited in independent claim 1, and as similarly recited in independent claims 10, 13, 16, 19, and 23?

ANALYSIS

We disagree with Appellants' conclusion regarding the obviousness of claims 1-27. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer (Ans. 3-18) in response to the Appellants' Appeal Brief. We concur with the conclusion reached by the Examiner. We highlight and address specific findings and arguments regarding the claim limitation of "ordering the list by physical location of the at least two backup devices based on proximity of the remaining backup devices of the at least two backup devices to the first backup device."

Appellants contend that the combination of Bolin and Jennings does not teach or suggest "ordering the list based on proximity of the remaining backup devices of the at least two backup devices to the first backup device." (App. Br. 10.) Appellants argue that "Bolin appears to only provide a home location column without providing corresponding proximity information or a mechanism for determining said proximity information.

(*Id.* at 11.) As explained by the Examiner, however, Bolin teaches that textual representations are used to identify racks of cartridges within a vault such as the text “VLT17R1” for vault 17, rack 4. (Ans. 12.) Moreover, Bolin’s cartridge racks qualify as the claimed backup devices because according to Appellants’ own specification, “backup devices may be tape libraries.” (Spec. 4:6.) In addition, as also explained by the Examiner, Jennings teaches “ordering a set of rows by a given column in ascending or descending order . . .” (Ans. 4, *citing* Jennings, table 3.2.) Thus, we find that the Examiner, giving the claim its broadest reasonable meaning consistent with the Specification, *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997), properly relies on the sorting of racks of cartridges by their textual representation as taught by the combination of Jennings and Bolin, as the claimed step of “ordering the list based on proximity of the remaining backup devices of the at least two backup devices to the first backup device.” Accordingly, we will sustain the Examiner’s rejection of claim 1 as well as claims 2-5, 7, 9-21, and 23-24 because Appellants did not set forth any separate patentability arguments for these claims. (*See* App. Br. 12, and 14-15.)

With respect to claim 6, the Examiner found that the claimed “order number” constitutes non-functional descriptive material which cannot “distinguish the claimed invention from the prior art in terms of patentability . . .” (Ans. 6.) Appellants argue that “[t]he order number, interpreted in the context of the instant specification (see specifically paragraph 23) is assigned based on physical proximity of data centers to each other.” (App. Br. 13.) But as explained by the Examiner, the claim language itself does not require the order number to be assigned based on physical proximity and

the limitations from the specification identified by Appellants may not be incorporated into the claims. (Ans. 17.) Accordingly, we will sustain the rejection of claim 6 as well as claims 22 and 25-27 because Appellants did not set forth any separate patentability arguments for those claims. (*See* App. Br. 13.)

In addition, Appellants argue that the Examiner erred in rejecting claim 8 as obvious because its “assertion that in *Bolin* the ‘order number would be the physical limitation’ is incorrect” (App. Br. 13.) Appellants argue that “[t]he physical location of *Bolin* is not both a physical location and an order number as claimed.” (*Id.*) As explained by the Examiner, however, “[t]here is nothing in the claim language that would render inconsistent an interpretation of the order number as being the physical location.” (Ans. 17.) Moreover, the combination of *Bolin* and *Jennings* teaches “ordering the list by an order number associated with each of the backup devices,” as recited in claim 8, because *Bolin* teaches that text may represent the order number and *Jennings* teaches that a list may be sorted by any text. (Ans. 3-5 and 7.) Accordingly, we will sustain the Examiner’s rejection of claim 8.

DECISION

We affirm the Examiner’s decision rejecting claims 1-27 as obvious.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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